

Claims 1 - 3 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

The Examiner's objection to claims 1 - 3 was phrased as a question: How can the compound react with epoxy groups and how can the molar amount of clathrate be ascertained relative to the epoxy resin when the epoxy resin is not a required component?

The question, to Applicant, seems rhetorical in that the questions are directed to a definition of one component and not to the claimed product, per se. The metes and bounds of applicant's invention are clearly set forth. See In re Gardner, 427 F.2d 786, 166 USPQ 138 (CCPA 1970) in which the court stated:

If the metes and bounds of a claimed invention are clearly ascertainable, then the claim . . . cannot properly be rejected as "vague and indefinite under the language of the second paragraph of §112.

Those skilled in the art can easily understand that applicant's invention, as stated in claim 1, for example, has two components which together form the clathrate. The compound in question, the "guest" or "other than the tetrakisphenol compound "host", is defined as one which reacts with epoxy groups of an epoxy resin to cure the resin and when in the presence of the tetrakisphenol forms the clathrate which then is to be present in such resin in the range of 0.001 to 0.1 molar of the epoxy groups. Such language defines the metes and bounds of the invention. As the Examiner has understood, the epoxy resin is

not a required component of the product claim, and applicants submit that the choice of language does not require that it be present.

The same comments apply equally to claim 2.

On the other hand, claim 3 does require the presence of an epoxy resin and clearly states that to be the case. Claim 3 has the clear metes and bounds of an epoxy resin containing the clathrate compounded from the host and guest components.

Accordingly, it is respectfully submitted that claims 1 - 3 are not vague and indefinite and fully comply with 35 U.S.C. §112, second paragraph.

Applicants acknowledge with appreciation the very helpful interview granted to applicants' representative by Primary Examiner Sellers on June 5, 2001. As a result of the interview, it was agreed that applicants would argue, as mentioned herein, the presence of a curative clathrate for claim 1, an accelerator clathrate for claim 2, and epoxy resin for claim 3, and epoxy resin for claim 5 comprising the curative clathrate of claim 1 and accelerator clathrate of claim 2. The Examiner indicated that restriction may be required between claim 1 as Group I, claim 2 as Group II, and claims 3 and 5 as Group III.

Therefore, applicants respectfully request that any restriction requirement be placed in writing to applicants in the next Action.

In which event, applicants now urge that restriction of this invention is not warranted. The restriction statute is not mandatory but permissive. There is no undue burden on the Office

to search each category as evidenced by the fact that actions on the merits have been given in prior two Office Action together with art citations. In addition, all of the claims have a common core, to wit: the tetrakisphenol.

Claims 1 - 3 and 5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent Nos. 5-194711 ('711) and 6-329570 ('570) and Asai et al. This rejection is respectfully traversed.

As the Examiner has noted, each of these references are totally defective in failing to teach or suggest the combined components of applicants invention. Examiner opines that it would have been obvious to employ the clathrates of '570 and Asai et al. as epoxy resin curing agents considering the teaching of '711 that clathrates of epoxy-reactive compounds are useful as curing agents and in the form of clathrates exhibit prolonged pot life. Applicant respectfully disagrees. It is not obvious to make this combination since the references themselves make no suggestion that such combinations be made. A prima facie case of obviousness has not been made out by the Office.

The legal arguments presented to the Office in applicant's response to the previous Examiner's Action (Paper No. 9) are incorporated herein by reference since such law is equally applicable to the instant §103(a) rejection.

It is to be noted that applicants claimed composition, compared to the cited and relied on prior art, has significant differences and significant unexpected properties, as evidenced

by the numerous examples and data contained in the present specifications, which would be unobvious.

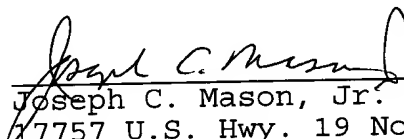
Accordingly, applicants respectfully submit that claims 1 - 3 and 5 are clearly patentable over '711, '570, and Asai either alone or in combination under 35 U.S.C. §103(a). Withdrawal of the rejection is respectfully requested.

A Notice of Allowances is earnestly solicited.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 538-3800 would be greatly appreciated.

MASON & ASSOCIATES, a  
Professional Association

Dated: June 7, 2001

  
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